

REMARKS

Claims 17-59 are pending in the application. Claims 34-46 and 55-59 are allowed. Reconsideration and withdrawal of the remaining rejections are requested in view of the following remarks.

The pending U.S. case includes a foreign priority claim to Japanese application serial no. 10-194448 (JP '448), which has a filing date of July 9, 1998. The pending claims are all supported by the JP '448 application, a certified copy and English translation of which have previously been filed with the USPTO, and are therefore entitled to the filing date of that application to antedate prior art references. The cited references have the following U.S filing/priority dates, all of which fall after the filing date of July 9, 1998:

Shibata '369 – Jan. 14, 1999

Shibata '942 – Jan. 29, 1999

Judge '447 – Aug. 14, 1998

Accordingly, none of the cited references are prior art against the pending claims. Thus, the § 102(e) rejections at paragraphs 3 and 4 of the Office Action, and the § 103 rejections at paragraph 9 of the Office Action, are no longer applicable.

With respect to the § 102(f) rejections at paragraph 5 of the Office Action, Applicants have included a Rule 1.132 declaration by Hisashi Higuchi, a named inventor on the two cited Shibata et al. design patents, explaining that he only contributed to the ornamental features of the design embodiments. Accordingly, he was properly not included as an inventor in the current case, as he did not contribute to the utilitarian aspects of the claimed invention.

With respect to the § 102(g) rejections at paragraph 6 of the Office Action, and the “statutory” double patenting rejections at paragraph 11 of the Office Action, Applicants submit that none of the rejected claims are directed to the same invention as either of the inventions claimed in the cited Shibata et al. design patents. First, a design-utility “same invention” double patenting rejection has no statutory basis, and thus can only be based on judicial doctrine (see MPEP, § 1504.06(I)). Moreover, for a “same invention” double patenting rejection to apply, the Examiner must be able to recreate the design claimed from the utility claims without any reliance whatsoever on the utility drawings (see MPEP, § 1504.06).

The ornamental designs claimed in the Shibata et al. design patents cannot be recreated from the rejected utility claims alone. First, several elements shown in the design patents are not recited in the utility claims. For example, rejected claims 17 and 47 do not recite the link mechanisms, saw arm structures, etc. that are shown in the design patents. Claim 17 also does not recite the saw handle, or the handle location, as shown in the design patents. Claim 47 does not recite a battery, a motor, etc.

In other words, several of the elements shown in each of the design patents are not recited in the rejected utility claims, and the claimed designs therefore cannot be recreated from the rejected utility claims alone. Accordingly, the rejected utility claims are not directed to the “same” invention as either of the cited design patents. Furthermore, a miter saw having a different ornamental design than either of those shown in the Shibata et al. design patents could literally infringe one or more of the rejected utility claims, but neither of the design claims. Thus, none of the utility claims are the “same” as either of the design claims.

Additionally, the two design patents are directed to two separate and different designs. Accordingly, none of the individual rejected utility claims can be the "same" as both design claims, which are not the same as each other. Moreover, rejected independent claims 17 and 47 each recite different structures, and therefore cannot be the "same" as one another. For example, claim 47 recites a handle, which claim 17 does not recite. Similarly, claim 47 does not recite several of the elements recited in claim 17. Thus, claims 17 and 47 are not the same as each other, the two Shibata et al. design claims are not the same as each other, and no single utility claim can logically be the same as both of the design claims. And as explained above, neither of the design claims can be recreated from any of the utility claims without any reliance whatsoever on the utility drawings. Thus, none of the utility claims are the same as either of the Shibata et al. design claims. Accordingly, the "same invention" double patenting rejections, as well as the § 102(g) rejections, are inappropriate, and Applicants submit that they should be withdrawn.

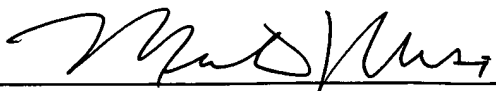
In view of the foregoing, it is submitted that the claims are in condition for allowance, and a Notice of Allowance is requested.

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Respectfully submitted,

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